

REMARKS/ARGUMENTS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office Action, and amended as necessary to more clearly and particularly describe and claim the subject matter that Applicants regard as the invention.

Claims 13–18 and 24 remain in this application. Claims 1–12 and 19–23 have been canceled as the result of an earlier restriction requirement, and Applicant retains the right to present those claims in a divisional application. New claims 25–28 have been added without adding any new matter.

The Examiner has indicated that claims 17 and 18 are allowed. Applicant notes that new claim 28 has limitations similar to allowed claim 17, and thus is allowable for the same reasons.

Claim 13 was rejected under 35 U.S.C. § 112, second paragraph, for insufficient antecedent basis. The claim has been amended, making the rejection moot.

Claims 13 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Holtzhammer *et al.* (U.S. 6,092,209), in view of Lenny (U.S. 6,467,054). Claims 14 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable as above, in further view of Reuter *et al.* (U.S. 6,226,717). Claim 16 was rejected as above in further view of Provino *et al.* (U.S. 6,601,081). For the following reasons, the rejections are respectfully traversed.

First, Applicant's representative disputes that the amendment is properly made final. For example, it appears that the Examiner has cited Lenny for teaching the storing means found in claims 13 and 14. The "storing means" was present in the claims as filed, and amendments to that claim element did not necessitate the finality of the action, because the

Examiner failed to cite any reference teaching storage means. Furthermore, the amendments to the storage means elements of those claims was for clarification purposes only, and did not substantively impact the claims. Thus, the Examiner has issued new grounds of rejection that were not *necessitated* by the amendments, as the Examiner failed to previously provide a teaching of those elements, and thus the finality was not proper, and should be withdrawn.

Claim 13 recites “a storing means for storing execution information containing an execution state of each of a plurality of hardware devices in respective operating systems.” Claim 14 recites “a storing means for storing power-saving mode information of each of a plurality of hardware devices in respective operating systems.” Claim 24 recites “a storage device for storing power-saving mode information about a hardware device with respect to each of said plurality of operating systems.” New claims 25–28 each have a similar limitation. The references fail to teach any such storage capability.

The Examiner has failed to show where in the cited references such a storage capability is taught. Note that the claim explicitly requires storing information about the hardware device in each of the plurality of operating systems. The Examiner cites Lenny as teaching setting a flag to identify a busy device, but there is no suggestion of storing mode information about a hardware device with respect to each of a plurality of operating systems.

Accordingly, claims 13, 14 and 24–28 are patentable over the references. The remaining rejected claims depend on one of claims 13, 14 and 24–28, and thus are patentable over the references for at least the same reasons.

Finally, the Examiner has not provided the proper motivation for modifying the AAPA according to the cited references. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP § 2142). To support a *prima facie* case of obviousness, the

Examiner must show that there is some *suggestion* or *motivation* to modify the prior art (MPEP § 2143.01). The prior art must suggest the *desirability* of the modification (*Id.*).

However, the motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP § 2142, last paragraph). “To reach a proper determination under 35 U.S.C. 103, the Examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the Examiner must then make a determination whether the claimed invention ‘*as a whole*’ would have been obvious at that time to that person.” (MPEP § 2142, emphasis added). In this case, the Examiner must be relying on the application itself for the motivation to modify the AAPA, because the Examiner has cited no other references, and this is clearly improper. The Examiner must find some motivation for modification outside of the application, and cannot rely on the application itself.

The Examiner is providing improper hindsight motivation, relying on the AAPA teachings, along with the teachings of the invention, to support the suggested modifications. Thus, the rejections are improper and should be withdrawn.

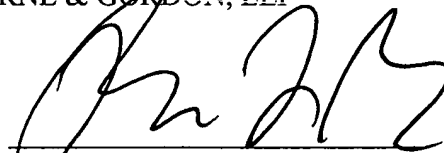
In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same
to our Deposit Account No. 16-0820, our Order No. 33452.

Respectfully submitted,

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